

## **REMARKS**

### **A. No Rejections Based on Prior Art**

Applicants note there is no rejection based on prior art. The only rejections noted in the Office Action are based on obviousness-type double patenting in view of Ser. No. 10/825,249 and Ser. No. 10/825,483.

### **B. Response to Requirement for Information**

#### **a. Partial Objection To Request For Information**

Applicants object to that portion of the Examiner's request which would purport to require Applicants to "identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims". This goes beyond a request for information and purports to require a review of such information and rendering an opinion regarding such information. Such a request is improper. "The terms 'factual' and 'facts' are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant." M.P.E.P. § 704.11 (emphasis added).

#### **b. Response Notwithstanding Objection**

Notwithstanding the foregoing objection to the request, Applicants appreciate the volume of applications and patents with similar subject matter. To assist the Examiner, Applicants have reviewed the patents and applications listed in the following tables. Enclosed is a document entitled "U.S. Patents And Patent Applications Identified In Response To Request For Information". This document recites the claims of all of these patents and applications listed in the following tables so that the Examiner can make an independent consideration of any potential double patenting issue.

Notwithstanding the foregoing, in the following section "C. Terminal Disclaimer", Applicants propose a listing of patents and applications for a terminal disclaimer. This listing is made to expedite prosecution and is made without any admission that any double patenting objection with respect to such patents or applications would be proper.

In the following tables, Applicants highlight the applications and patents listed on page 5 of the Office Action.

**Patents And Applications With Entire Disclosure Claiming Priority To Ser. No. 09/398,991 Filed September 17, 1999 (Now U.S. Pat. No. 6,250,307)**

Attorney Docket Suffix (Prefix 13033)	Serial No.	Filing Date	Patent No.	Issue Date
1US01	09/398,991	9/17/99	6,250,307	6/26/01
1USC1	09/872,699	6/1/01	6,523,543	2/25/03
1USC2	09/872,789	6/1/01	6,601,585	8/5/03
1USC3	09/872,545	6/1/01	6,626,181	9/30/03
1USC8	10/629,490	7/29/03	Pending	
1US11	10/938,255	9/9/04	Pending	
1US14	11/196,811	8/3/05	Pending	

**Patents And Applications With A Portion Of The Disclosure Claiming Priority To Ser. No. 09/398,991 Filed September 17, 1999 (Now U.S. Pat. No. 6,250,307)**

Attorney Docket Suffix (Prefix 13033)	Serial No.	Filing Date	Patent No.	Issue Date
1USC4	10/036,915	1/3/02	6,634,362	10/21/03
1USC5	10/121,166	4/11/02	6,578,580	6/17/03
1USC6	10/434,517	5/7/03	6,848,447	2/1/05
1USC7	10/449,186	5/30/03	Pending	
1USC9	10/824,673	4/15/04	Pending	
1US10	10/843,052	5/10/04	Pending	
1US12	10/948,352	9/23/04	Pending	
1US13	11/011,741	12/14/04	Pending	
1USI1	09/434,653	11/5/99	6,401,717	6/11/02
1USI2	09/513,042	2/25/00	6,453,905	9/24/02
1USI3	09/513,039	2/25/00	6,415,796	7/9/02
1USI4	09/513,432	2/25/00	6,450,169	9/17/02
1USI5	09/602,141	6/23/00	6,390,096	5/21/02
1USI6	09/814,471	3/21/01	6,513,530	2/4/03
1USI7	09/814,460	3/21/01	6,513,531	2/4/03
1USI8	09/815,154	3/21/01	6,523,541	2/25/03

1USI9	09/815,166	3/21/01	6,523,542	2/25/03
1USIA	09/814,456	3/21/01	6,516,806	2/11/03
1USIB	09/814,459	3/21/01	6,601,584	8/5/03
1USIC	09/992,277	11/14/01	6,502,574	1/7/03

**Patents And Applications With Entire Disclosure Claiming Priority To The Earliest  
Claimed Priority Date Of The Present Application (i.e., priority claimed to Ser. No.  
09/636,803 Filed August 10, 2000 (Now U.S. Pat. No. 6,431,174))**

Attorney Docket Suffix (Prefix 13033)	Serial No.	Filing Date	Patent No.	Issue Date
4US01	09/636,803	8/10/00	6,431,174	8/13/02
4USC1	10/190,183	7/3/02	6,546,936	4/15/03
4USC2	10/394,887	3/21/03	6,742,524	6/1/04
4USC3	10/629,145	7/29/03	6,971,396	12/6/05
4USC4	10/825,029	4/14/04	Pending	
4USC5	10/825,249	4/14/04	Pending	
4USC6	11/197,271	8/3/05	Pending	

**Patents And Applications With Entire Disclosure Claiming Priority To Ser. No. 10/066,967  
Filed February 4, 2002**

Attorney Docket Suffix (Prefix 13033)	Serial No.	Filing Date	Patent No.	Issue Date
5US01	10/066,967	2/4/02	Pending	

**Patents And Applications With A Portion Of The Disclosure Claiming Priority To Ser. No.  
10/066,967 Filed February 4, 2002**

Attorney Docket Suffix (Prefix 13033)	Serial No.	Filing Date	Patent No.	Issue Date
5USI1	10/237,149	9/6/02	7,017,582	3/28/06
5USC1	10/825,483	4/14/04	Pending	
5USC2	11/179,184	7/12/05	Pending	
5USC3	11/196,690	8/3/05	Pending	

**Patents And Applications Claiming Priority, In Whole Or Part, To Ser. No.  
10/698,818 Filed October 31, 2003**

<b>Attorney Docket Suffix (Prefix 13033)</b>	<b>Serial No.</b>	<b>Filing Date</b>	<b>Patent No.</b>	<b>Issue Date</b>
12US01	10/698,819	10/31/03	Pending	
12US11	10/877,003	6/24/04	Pending	

**C. Terminal Disclaimer**

Applicants do not believe the present application is properly subject to a same invention-type double patenting rejection with respect to any of the foregoing.

Without admission that the present claims are obvious in view of the claims of the above cited patents or applications of assignee, and to expedite allowance of the present application, a terminal disclaimer is submitted herewith with respect to the following:

<b>Attorney Docket Suffix (Prefix 13033)</b>	<b>Serial No.</b>	<b>Filing Date</b>	<b>Patent No.</b>	<b>Issue Date</b>
4USC4	10/825,029	4/14/04	Pending	
1USC8	10/629,490	7/29/03	Pending	
1USC9	10/824,673	4/15/04	Pending	
4USC1	10/190,183	7/3/02	6,546,936	4/15/03

Applicants request reconsideration of the provisional obviousness-type double patenting rejection with respect to Ser. No. 10/825,483. All claims of that application are directed to an implant with a longitudinal axis placed transverse to an axis of the pharyngeal airway. No such limitations appear in the present claims. Further, such limitations would not be suggested by the present claims. Therefore, the claims of the two applications are patentably distinct.

**D. Prior Terminal Disclaimer**

Applicants remind the Examiner that in response to the July 1, 2005 Office Action, Applicants filed a terminal disclaimer with respect to the following commonly assigned patents:

Patent No.	Attorney Docket Suffix (Prefix 13033)
6,848,447	1USC6
6,516,806	1USIA
6,523,542	1USI9
6,634,362	1USC4
6,742,524	4USC2
6,513,530	1USI6
6,453,905	1USI2
6,450,169	1USI4

**E. Conclusion**

Applicants submit this application is now in condition for allowance. Reconsideration and Notice of Allowance are solicited. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(612) 332-5300

Date: \_\_\_\_\_

4/19/06



Timothy R. Conrad  
Reg. No. 30,164